

REMARKS

The Office Action dated June 18, 2008 has been received and carefully considered. In this response, claims 1, 12, 17 and 27 have been amended, and claims 4 and 30 have been canceled. No new matter has been added. Entry of the amendments to claims 1, 12, 17 and 27 is respectfully requested. Reconsideration of the current objections/rejections in the present application is also respectfully requested based on the following remarks.¹

I. **THE OBJECTION TO THE OATH/DECLARATION**

On page 2 of the Office Action, the Examiner alleges that the oath or declaration is defective because it does not identify the mailing address of each inventor. In particular, the Examiner notes that there is no zip code provided for inventor Breslin, and the zip code for inventor deGottal is illegible. The Examiner indicates that the mailing address may be provided in an application data sheet or a supplemental oath or declaration. Applicant appreciates the Examiner bringing this to Applicant's attention.

Pursuant to 37 C.F.R. §1.76(d), Applicant hereby submits a "Supplemental Application Data Sheet" that provides the zip codes for the above named inventors. In view of the foregoing, it is respectfully requested that the aforementioned objection to the oath and declaration be withdrawn.

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions made by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

II. THE OBJECTION TO CLAIMS 2, 4, 28 AND 30

On page 2 of the Office Action, claims 2, 4, 28 and 30 were objected to under 37 CFR §1.75 as being of improper dependent form or having some other informality.

Regarding claims 4 and 30, the Examiner alleges they are duplicates of claims 2 and 28, respectively. Applicant agrees and has canceled claims 4 and 30.

Regarding claims 12 and 17, the Examiner alleges that they contain certain informalities. Applicant agrees and has amended each of claims 12 and 17 to cure the informalities referenced by the Examiner.

In view of the foregoing, it is respectfully requested that the aforementioned objection to claims 2, 4, 28 and 30 be withdrawn.

III. THE ANTICIPATION REJECTION OF CLAIMS 1, 2, 4-12, 17-19, 27, 28, 30-35 AND 39-41

On page 3 of the Office Action, claims 1, 2, 4-12, 17-19, 27, 28, 30-35 and 39-41 were rejected under 35 U.S.C. § 102(e) as being anticipated by Borgia (U.S. Publication No. 2002/0129221). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re King, 801 F.2d 1324, 1326 (Fed. Cir. 1986). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Celeritas Tech., Ltd., v. Rockwell Int'l Corp., 150 F.3d 1354, 1361 (Fed. Cir. 1998). "In addition, the prior art reference must be enabling." Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d

531, 533 (Fed. Cir. 1985). Such possession is effected only if one of ordinary skill in the art could have combined the disclosure in the prior art reference with his/her own knowledge to make the claimed invention. Id.

Regarding claim 1, the Examiner asserts that Borgia discloses the claimed invention. Applicant respectfully disagrees. However, in order to forward the present application toward allowance, Applicant has amended claim 1 to more specifically define the claimed invention, and specifically those features that differentiate the claimed invention from the cited references. In particular, Applicant has amended claim 1 to recite the step of “developing a recovery plan for recovery from a loss of use of the at least one resource, wherein the recovery plan aims to ensure the business continuity of the at least one resource.” Applicant respectfully submits that Borgia does not disclose such functionality. In contrast, Borgia discloses a system for tracking “compliance with policies related to the management of risk for a given enterprise. *See* Borgia, Abstract. Applicant submits that tracking compliance with certain policies is not the same as providing business continuity in an enterprise by, among other things, developing a recovery plan for recovery from a *loss of use of the at least one resource, wherein the recovery plan aims to ensure the business continuity of the at least one resource.* Indeed, Applicant respectfully submits that there is no teaching or suggestion in Borgia of a resource whose use has been lost, as expressly required by claim 1. Accordingly, it is respectfully submitted that claim 1, as amended, is allowable over Borgia.

Regarding claim 27, this claim recites subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claim 27. Accordingly, it is respectfully submitted that claim 27 is allowable over Borgia for the same reasons as set forth above with respect to claim 1.

Regarding claims 2-3, 5-19, 28-29,31-41 and 47, these claims are dependent upon independent claim 1 or 27. Thus, since independent claims 1 and 27 should be allowable as discussed above, claims 2-3, 5-19, 28-29,31-41 and 47 should also be allowable at least by virtue of their dependency on independent claim 1 or 27. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination. For example, claim 5 recites the method of claim 1, wherein the at least one resource is a department within the enterprise, the step of collecting resource information further comprises at least one of: collecting resource information with respect to software applications relied on by the department; and collecting resource information with respect to external vendors relied on by the department. Applicant respectfully submits that none of the cited reference -- alone or in combination -- teach or suggest the method according to claim 1, wherein the at least one resource is a department within the enterprise, the step of collecting resource information further comprises at least one of: collecting resource information with respect to software applications relied on by the department; and collecting resource information with respect to external vendors relied on by the department.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1, 2, 4-12, 17-19, 27, 28, 30-35 and 39-41 be withdrawn.

IV. THE OBVIOUSNESS REJECTION OF CLAIMS 3, 13-16, 29 AND 36-38

On page 8 of the Office Action, claims 3 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Borgia (U.S. Publication No. 2002/0129221) in view of Davenport (U.S. Publication No. 2004/0103431). On page 9 of the Office Action, claims 13-16 and 36-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Borgia in view of Jacobs (U.S. Patent No. 5,185,697). These rejections are hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or “secondary considerations,” of non-obviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); see also KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). An “expansive and flexible approach” should be applied when determining obviousness based on a combination of prior art references. KSR, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. Id. at 1741. Rather, there must still be some “reason that would have prompted” a person of ordinary skill in the art to combine the elements in the specific way that he or she did. Id.; In re Icon Health & Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. KSR, 127 S. Ct. at 1740-41.

It is respectfully submitted that the aforementioned obviousness rejection of claims 3, 13-16, 29 and 36-38 has become moot in view of the deficiencies of the primary reference (i.e., Borgia) as discussed above with respect to independent claims 1 and 27. That is, claims 3, 13-16, 29 and 36-38 are dependent upon independent claim 1 or 27 and thus inherently incorporate all of the limitations of independent claim 1 or 27. Also, the secondary references (i.e., Davenport and Jacobs) fail(s) to disclose, or even suggest, the deficiencies of the primary reference Borgia as discussed above with respect to independent claim 1 and 27. Indeed, the Examiner does not even assert such. Thus, the combination of the secondary references with the

primary reference also fails to disclose, or even suggest, the deficiencies of the primary reference as discussed above with respect to independent claims 1 and 27. Accordingly, claims 3, 13-16, 29 and 36-38 should be allowable over the combination of the secondary reference with the primary references at least by virtue of its/their dependency on independent claim 1 and 27. Moreover, claims 3, 13-16, 29 and 36-38 recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 3, 13-16, 29 and 36-38 be withdrawn.

V. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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